

REMARKS

Applicant's representative wishes to express appreciation for the opportunity to discuss the application with Examiner Antony Nguyen-Ba during a telephone interview on August 2, 2005. Examiner Nguyen-Ba was asked whether a change in claim terms would clarify the difference of the claimed invention over the Inaba reference. Examiner Nguyen-Ba suggested that the claims be drafted according to the figures of the application. No agreements were reached regarding any amendments to the claims.

Amendments to the Claims

Claim 1 has been amended to conform the claim to the figures, and to include additional detail from the specification. Support for the amendment may be found, for example, in Figure 3, in paragraph [0048], and in PCT Application having publication number WO/02/41147 A1, and having application number PCT/US01/44034, filed on November 19, 2001, the complete subject matter of which was incorporated in the Application, in its entirety, at the time the Application was filed. The Applicants submit that no new subject matter is added by this amendment.

Claim 2 has been amended to correct antecedent basis. The Applicants submit that no new subject matter is added by this amendment.

Claim 19 has been amended to conform the claim to the figures, and to include additional detail from the specification. Support for the amendment may be found, for example, in Figures 1 and 3, in paragraph [0048], and in PCT Application having publication number WO/02/41147 A1, and having application number PCT/US01/44034, filed on November 19, 2001, the complete subject matter of which was incorporated in the Application, in its entirety, at the time the Application was filed. The Applicants submit that no new subject matter is added by this amendment.

Claim 20 has been amended to correct a noted minor typographical error, and to correct antecedent basis. The Applicants submit that no new subject matter is added by this amendment.

Claims 25, 27, 29, and 30 have been amended to correct noted minor typographical errors. The Applicants submit that no new subject matter is added by these amendments.

Rejections of Claims

Claims 1-37 are pending in the application. Claims 1-35 were originally submitted in an application filed October 30, 2003. Claims 1-35 were rejected in an Office action mailed December 10, 2004. Claims 1, 6, 7, 9, 10-16, 18-35 were amended, and claims 36-37 were added in a response to the Office action of December 10, 2004, filed March 9, 2005. Claims 1-37 were rejected in the final Office action mailed June 14, 2005. Claims 1 and 19 are independent claims. Claims 2-18 and 36, and claims 20-35 and 37 depend either directly or indirectly from independent claims 1 and 19, respectively. New claims 38 and 39 have been added. The Applicants request reconsideration of the pending claims 1-37, and new claims 38 and 39, in light of the following remarks.

As an initial matter, it should be noted that although this document presents substantive responses to the references cited in the Office action of June 14, 2005, this submission is in no way intended as an admission that the cited references constitute prior art under any subsection of 35 U.S.C. § 102. Applicants expressly retain the right to argue that any of the cited references are not indeed prior art or to take any actions necessary to remove any of the cited references from the available prior art.

Claims 1-10, 19-27, and 35 were rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application No. 2001/0008024 A1 by Inaba. The Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding amended claim 1, the Applicants submit that the Inaba reference does not teach, suggest, or disclose, for example, a method for updating an electronic device, using an update package comprising update information, the method comprising applying the update

package to the electronic device by updating a first code version in the electronic device to a second code version, the update information comprising a set of instructions, wherein execution of the instructions transforms the first code version into the second code version; and invoking at least one converter utility for converting data associated with the first code version to a form compatible with the second code version, based upon the update information and a list of names of converter utilities associated with the update information. More specifically, claim 1 is different from the teaching of Inaba, in that the Inaba reference fails to teach, suggest, or disclose anything with respect to the existence or use of update information comprising a set of instructions, wherein execution of the instructions transforms a first code version into a second code version. The Applicants respectfully submit that Inaba merely teaches upgrading as resulting from downloading of software, replacing a unit apparatus, and downloading of operational data. (see, e.g., par. [0010]-[0014]) Inaba states that its invention provides a data processing system comprising “a system version management information storing unit 8 which stores therein system acceptable software and system version information.” (see, e.g., para. [0015]) Inaba clearly describes the downloading and storing of software. (see, e.g., para. [0034]-[0036]) However, Inaba fails to teach anything related to the transforming of a first code version into a second code version. No method of acquiring such acceptable software, other than by downloading, is disclosed by Inaba. Therefore, acceptable software must be received by the system of Inaba, and is not the result of a transformation occurring in the electronic device.

The Applicants also respectfully submit that Inaba fails to teach, suggest, or disclose a list of names of converter utilities associated with the update information. Inaba merely teaches that the DBS conversion processing unit 27 converts a system operational data format that is not the latest format, to the latest system operational data format. (see, e.g., paras. [0039] and [0049]) Inaba fails to provide any details about how the conversion is performed. To be more specific, Inaba fails to teach the existence of multiple converter utilities, or a list of list of names of converter utilities.

Regarding claim 2, the Applicants appreciate recognition by the Examiner that “Inaba does not specifically disclose retrieving a list of names of converter utilities associated with the update information.” (see Office action, page 5) The Office action alleges that “this step is deemed inherent to Inaba teachings because as can be seen in Figure 1 (and related discussion in

the specification), steps 8, 9 provide information about data conversion which **may** also provide list of converter utilities.” (see Office action, page 5) (emphasis added) The Applicants strongly disagree. The Applicants respectfully point out that according to MPEP §2112, Sec. IV, page 2100-54,55, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient.’” (emphasis added) The Applicants respectfully submit that there are many ways in which the conversion of operational data of Inaba may be implemented that do not involve retrieving a list of names of converter utilities associated with the update information. For example, information may be provide to the DBS conversion processing unit 27 that instructs how the operational data is to be modified. The Applicants respectfully submit that Inaba is silent with regard to anything related to how the conversion operation of the DBS conversion processing unit 27 works. The Applicants respectfully submit, therefore, that a rejection based upon inherency cannot be maintained.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Inaba is different from and fails to anticipate the Applicants’ invention as set forth in claim 1, as amended. Because claims 2-18 and 36 depend either directly or indirectly upon claim 1, Inaba is different from and fails to anticipate claims 2-18 and 36, as well. Therefore, the Applicants believe that claims 1-18 and 36 are allowable over the Inaba reference. The Applicants respectfully request that the rejection of claims 1-10 under 35 U.S.C. §102(a), be withdrawn.

Regarding amended claim 19, the Applicants respectfully submit that the Inaba reference does not teach, suggest, or disclose, for example, a machine-readable storage, having stored thereon a computer program having a plurality of code sections executable by a machine for causing the machine to perform operations for updating an electronic device using an update package comprising update information, the machine-readable storage comprising code comprising an update agent, for applying the update package to the electronic device by updating of code in the electronic device, the-update information comprising a set of instructions, wherein execution of the instructions transforms the code to an updated code; and code comprising a converter, for invoking at least one converter utility associated with the code and for converting

data associated with the code to a form compatible with an updated version of the code, based upon the update information and a list of names of converter utilities associated with the update information.

The arguments that were presented in the Office action in support of the rejection of claim 19 are the identical to those presented with respect to the rejection of claim 1. Therefore, the Applicants respectfully submit that claim 19 is allowable for at least the same reasons given above with respect to claim 1.

Regarding amended claim 25, the Applicants appreciate recognition by the Examiner that “Inaba does not specifically disclose a placement layout table for mapping a memory location of update information, the placement layout table at least mapping an update information memory location and a list of names of converter utility memory location.” (see Office action, page 5) The Office action alleges that “this table is deemed inherent to Inaba’s teachings as Figure 1 shows conversion operations between items 3 and 5. Without a table as claimed, the conversion process would not be feasible.” The Applicants disagree. Again, the Applicants respectfully point out that according to MPEP §2112, Sec. IV, page 2100-54,55, “[t]o establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing **may** result from a given set of circumstances is not sufficient.’” (emphasis added) As discussed above with respect to claim 1, the Applicants respectfully submit that Inaba fails to teach, suggest, or disclose a list of names of converter utilities associated with the update information. To be more specific, Inaba fails to teach the existence of multiple converter utilities, or a list of names of converter utilities. The Applicants respectfully submit that there are many ways in which the conversion operations of Inaba may be implemented that do not involve mapping a list of names of converter utilities (or their memory locations) with the update information. For example, information may be provide to the DBS conversion processing unit 27 of Inaba, that instructs how the operational data is to be modified. The Applicants respectfully submit, therefore, that a rejection based upon inherency cannot be maintained.

Therefore, for at least the above stated reasons, the Applicants respectfully submit that Inaba is different from and fails to anticipate the Applicants' invention as set forth in claim 19, as amended. Because claims 20-35 and 37 depend either directly or indirectly upon claim 19, Inaba is different from and fails to anticipate claims 20-35 and 37, as well. Therefore, the Applicants believe that claims 19-35 and 37 are allowable over the Inaba reference. The Applicants respectfully request that the rejection of claims 19-27 and 35 under 35 U.S.C. §102(a), be withdrawn.

Claims 11-18 and 29-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2001/0008024 A1 by Inaba, as applied to claims 1-10 and 19-27, in view of U.S. Patent No. 6,587,684 to Hsu et al ("Hsu"). The Applicants respectfully traverse the rejection. Regarding claims 11-18, claims 11-18 depend directly or indirectly upon amended independent claim 1. Because amended claim 1 is allowable, the Applicants respectfully submit that claims 11-18 are allowable over the proposed combination of references. Therefore, the Applicants respectfully request that the rejection of claims 11-18 under 35 U.S.C. §103(a), be withdrawn.

Regarding claims 29-34, claims 29-34 depend directly or indirectly upon amended independent claim 19. Because amended claim 19 is allowable, the Applicants respectfully submit that claims 29-34 are allowable over the proposed combination of references. Therefore, the Applicants respectfully request that the rejection of claims 29-34 under 35 U.S.C. §103(a), be withdrawn.

Newly Added Claims

Claim 38 and 39 have been added. Claim 38 depends from independent claim 1, while claim 39 depends from independent claim 19. Support for these new claims may be found, for example, in Figure 1, in paragraph [0048], and in PCT Application having publication number WO/02/41147 A1, and having application number PCT/US01/44034, filed on November 19, 2001, the complete subject matter of which was incorporated in the Application, in its entirety, at the time the Application was filed. The Applicants believe that claims 38 and 39 are allowable for at least the same reasons as claims 1 and 19, respectively.

Conclusion

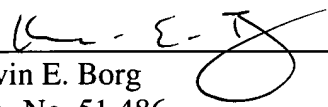
The Applicants believe that all of claims 1-39 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

Dated: August 10, 2005



Kevin E. Borg
Reg. No. 51,486

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street
Suite 3400
Chicago, Illinois 60661
Phone (312) 775-8000
Facsimile (312) 775-8100